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Berkeley National Laboratory  
Office of the Laboratory Counsel  
Patent Department  
MS 90B-0104

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DEC 17 2004  
**FAX**

DATE: 12/17/04

TO: Examiner Misook Yu

FAX: (703) 872-9306

LOCATION: In the United States Patent and Trademark Office

TEL: (571) 272-0839

FROM: Michelle S. Chew

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TOTAL NUMBER OF PAGES (INCLUDING THIS ONE): 8

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**PLEASE DELIVER TO EXAMINER MISOOK YU.**

Practitioner's Docket No. IB-1398

*PATENT*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Mina J. Bissell et al.

Application No.: 09/652,493

Group No.: 1642

Filed: August 31, 2000

Examiner: Yu

For: Design of Novel Drug Screens based on the Newly Found Role of Dystroglycan Proteolysis in Tumor Cell Growth

**REMARKS:**

Dear Examiner Yu:

Attached to this cover sheet is a response to the Notice of Non-Compliant Amendment mailed 12/10/04 for the application listed above. If you encounter any problems with this transmission, please call me at (510) 495-2456. Thank you.

Respectfully submitted,

Michelle S. Chew, Esq.

Reg. No. 50,456

Ernest Orlando Lawrence Berkeley National Laboratory  
One Cyclotron Road | Berkeley, California 94720

DEC 17 2004

PTO/SB/21 (09-04)

Approved for use through 07/31/2008, OMB 0651-0031

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|   |                      |                        |         |
|---|----------------------|------------------------|---------|
| <b>TRANSMITTAL FORM</b><br><br>(to be used for all correspondence after initial filing) | Application Number   | 09/652,493             |         |
|   | Filing Date          | August 31, 2000        |         |
|   | First Named Inventor | Mina J. Bissell        |         |
|   | Art Unit             | 1642                   |         |
|   | Examiner Name        | Misook Yu              |         |
| Total Number of Pages in This Submission  | 8                    | Attorney Docket Number | IB-1398 |

| ENCLOSURES (Check all that apply)  |  |  |
|--|--|--|
| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input checked="" type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br><input type="checkbox"/> Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input type="checkbox"/> Other Enclosure(s) (please identify below): |
| Remarks _____  |  |  |

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

|              |                                       |          |        |
|--------------|---------------------------------------|----------|--------|
| Firm Name    | Lawrence Berkeley National Laboratory |          |        |
| Signature    | <i>Michelle S. Chew</i>               |          |        |
| Printed name | Michelle S. Chew                      |          |        |
| Date         | 12-17-2004                            | Reg. No. | 50,456 |

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

|                       |                            |      |            |
|-----------------------|----------------------------|------|------------|
| Signature             | <i>Sharon Kay Reineman</i> |      |            |
| Typed or printed name | Sharon Kay Reineman        | Date | 12/17/2004 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No. 09/652,493  
Amdt. Dated December 17, 2004  
Reply to Office action of May 18, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/652,493  
Applicant : Mina J. Bissell et al.  
Filed : August 31, 2000  
Title : DESIGN OF NOVEL DRUG SCREENS BASED ON THE NEWLY  
FOUND ROLE OF DYSTROGLYCAN PROTEOLYSIS IN TUMOR  
CELL GROWTH  
TC/A.U. : 1642  
Examiner : Misook Yu  
DocketNo. : IB-1398

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE UNDER 37 C.F.R. § 1.8(a)(1)(i)(B)

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being facsimile transmitted to the United States Patent and Trademark Office, at (703) 872-9306 on December 17, 2004.

Dated: 12/17/04

By:

Michelle S. Chew Sharon Kay Reineman

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT  
MAILED 12/10/04

Dear Sir:

The following communication is responsive to the Notice of Non-Compliant Amendment mailed December 10, 2004. Accordingly, a Response is due on January 10, 2005 without extension. Thus, this Response is timely filed within the one month period of reply. Applicants request reconsideration of the above application in view of the following resubmitted claims. Please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 5 of this paper.